

Application No.: 10/002560

Case No.: 56911US002

Remarks

Favorable consideration of this application is respectfully requested. Claims 1-40 are pending in the application.

Restriction Under 35 USC § 121

In the Office Action, restriction to one of the following inventions was required under 35 USC § 121:

- I. Claims 1-12 and 23-40 are said to be drawn to a method of capping a web having stems, classified in Class 264, subclass 40.5;
- II. Claims 13-22 are said to be drawn to a set of calendar rolls, classified in Class 425, subclass 149.

The inventions are distinct, each from the other because the inventions of groups I and II are related as process and apparatus for its practice. The Examiner averred that the apparatus as claimed can be used to practice another and materially different process such as one that produces a flat polymeric film. Thus the Examiner concluded that the restriction for examination purposes is proper because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification.

Applicants' Response to the Restriction under 35 U.S.C. 121

Applicants elect, with traverse, the invention of group I comprising to a method of capping a web having stems directed to claims 1-12 and 23-40.

Applicants respectfully traverse the restriction requirement and the election of species requirement. M.P.E.P. § 803 requires that the two conditions be met for a proper requirement for restriction between patentably distinct inventions. First, the inventions must be independent or distinct as claimed. Second, there must also be serious burden on the Examiner if restriction is not required (see M.P.E.P. §803.02; §806.04 (a)-(j); §808.01 (a); and §808.02).

Applicants submit the restriction between groups I and II is improper because the claims would not impose a serious burden on the Examiner if both groups were prosecuted under the same application. In support, applicants respectfully point out that the classes and subclasses of groups I and II that were identified by the Examiner to support the restriction are both directed to

Application No.: 10/002560

Case No.: 56911US002

the pressure molding of polymers. Class 264/40.5 is directed to processes wherein the pressure of a mold part on the molding material is controlled. Class 425/149 is directed to an apparatus comprising means responsive to the force applied to material during shaping for regulating, controlling or adjusting the pressure applying means. Applicants respectfully assert that a search involving either group would necessitate a search in the other group's class or subclass in order to effectively understand the background art. Thus a serious burden would not be imposed upon the Examiner. Withdrawal of the restriction and continued prosecution of the claims is respectfully requested.

It is believed that no fee is due; however, in the event a fee is required, please charge the fee to Deposit Account No. 13-3723. The Examiner is invited to contact the undersigned at the indicated telephone number with questions that can be resolved with a simple teleconference.

Respectfully submitted,

February 20, 2004

Date

By:

Brian E. Szynowski, Reg. No.: 39,523
Telephone No.: (651) 737-9138

Office of Intellectual Property Counsel
3M Innovative Properties Company
Facsimile No.: 651-736-3833